

REMARKS

I. Formalities

Applicant thanks the Examiner for indicating that the Formal Drawings filed on October 11, 2000 have been accepted.

Applicant notes, however, that the Examiner still has not signed and forwarded a copy of the PTO 1449 Form submitted by Applicant with the Information Disclosure Statement filed on April 3, 2003, as requested in the Amendment filed on April 8, 2004. Accordingly, Applicant respectfully requests that the Examiner sign the aforementioned PTO 1449 Form, initial the references cited therein, and return it along with the next office paper.

II. Status of the Application

By the present amendment, claims 3-4, 6, 8, 14-16, 20 and 24 have been amended for reasons of grammar. The amendments to claims 3-4, 6, 8, 14-16, 20 and 24 are not made for patentability reasons and do not narrow the scope of the claims. Claims 1-30 are all the claims pending in the application, with claims 1, 10, 18, 21 and 25 being in independent form. The Examiner has rejected claims 1-30.

The present response addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

III. Claim Rejections under 35 USC § 103 – Terashima in view of Lincke

The Examiner has rejected claims 1-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,970,419 to Terashima *et al.* (hereinafter “Terashima”) in view of U.S.

Patent Application Publication 2003/0197719 to Lincke *et al.* (hereinafter “Lincke”). Applicant respectfully traverses this rejection for *at least* the reasons set forth below.

A. Independent Claim 1

Independent claim 1 requires a combination of elements including *at least*:

light-emission control means for stopping light-emission by said light-emitting means upon start of the reception of said data by said reception means...

The Examiner acknowledges that Terashima fails to teach or suggest the above recitation. See 11/24/2004 Office Action page 3, lines 2-10. Nevertheless, the grounds of rejection rely on Lincke, alleging that paragraph 7 of Lincke teaches a reception means, as recited in claim 1. Paragraph 7 of Lincke teaches simply that wireless networks may include cellular phones and pager systems. See Paragraph 7. Thus, the grounds of rejection apparently allege that the cellular phones and/or pager systems disclosed in paragraph 7 of Lincke correspond to “a communication terminal device,” as recited in claim 1.

The grounds of rejection also allege that paragraph 517 of Lincke teaches that an end-of-file indication is received and the transmission is shut down, thereby ultimately saving power as suggested in paragraph 57 of Lincke. Further, the grounds of rejection allege that it would have been obvious to one of ordinary skill to modify the communication device taught in Terashima to use the reception means taught by Lincke, where the reception means is provided to receive data as well as voice signals that can control light-emitters when a predetermined code has been detected.

However, the Examiner acknowledges that a combination of Terashima and Lincke would still not arrive at the present invention since, neither Terashima nor Lincke teach or suggest a light-emission control means for stopping light-emission by said light-emitting means upon start of the reception of said data by said reception means, as required by claim 1. *See* 11/24/2004 Office Action, page 4, lines 2-3. Nonetheless, the grounds of rejection summarily allege that “one could be so inclined to control the power of the light-emitters when a code is detected in any way for the benefit of saving power,”¹ without providing any evidentiary support for this assertion. 11/24/2004 Office Action, page 4, lines 3-4.

Applicant respectfully disagrees with the grounds of rejection since they clearly do not even establish a *prima facie* case of obviousness under 35 U.S.C. §103. In order for the Examiner to establish a *prima facie* case of obviousness, it is incumbent on the Examiner to demonstrate that Terashima, Lincke, or some combination thereof, teaches or suggests all of the limitations of claim 1. *See* MPEP § 2143. However, as plainly acknowledged by the Examiner on page 4, lines 2-3 of the 11/24/2004 Office Action, neither Terashima, Lincke, nor any combination thereof, teaches or suggests a light-emission control means for stopping light-emission by said light-emitting means upon start of the reception of said data by said reception means, as recited in claim 1. *See* 11/24/2004 Office Action, page 4, lines 2-3. Indeed, the

¹ Applicant notes that claim 1 not only recites “starting light-emission... upon detection of said predetermined code...”, but claim 1 also plainly recites “...stopping light-emission by said light-emitting means upon start of the reception of said data by said reception means...” (emphasis added). Thus, any suggestion by the Examiner’s that claim 1 is directed only to controlling the power of the light-emitters when a code is detected is clearly inaccurate.

grounds of rejection have not pointed to any specific portion of either Terashima or Lincke that teaches or suggests this feature.

Nevertheless, the Examiner summarily alleges that “one could be so inclined to control the power of the light-emitters when a code is detected in any way for the benefit of saving power,” without providing any evidentiary support for this bald assertion whatsoever.

11/24/2004 Office Action, page 4, lines 3-4. However, mere allegations by the Examiner that certain differences between the claimed subject matter and the prior art are obvious do not create a presumption of unpatentability. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963). To the contrary, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *In re Lahu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984).

Here, the Examiner summarily concludes that one could be so inclined to invent the novel method of controlling light emission to reduce power consumption recited in claim 1, without establishing any factual basis to support his conclusion, and without providing any objective teaching to this effect in the cited references. Thus, Applicant submits that the Examiner’s rejection is improper for *at least* these reasons.

Further, neither Terashima, nor Lincke, nor any combination thereof provide any teaching or suggestion whatsoever regarding a means for stopping light-emission upon start of the reception of data, as recited in claim 1. Indeed, the Examiner acknowledges that Terashima

does not teach or suggest this feature. 11/24/2004 Office Action, page 3, lines 2-10.

Nevertheless, the Examiner relies on Lincke as teaching this feature.

However, Lincke clearly does not cure the deficient teachings of Terashima. In contrast, Lincke teaches that the wireless client 405 transmits a request message, and that “[w]hen the entire request message has been transmitted, the wireless client 405 shuts down the transmit side of the client’s connection, causing the proxy server 180 to receive an end-of-file indication” (emphasis added). Paragraph 0517. That is, Lincke teaches that, upon transmitting the entire request message, the wireless client 405 shuts down the transmission side of the TCP connection. Therefore, Lincke does not teach stopping light-emission of any kind, as required by claim 1, much less stopping light-emission upon start of the reception of data.

Additionally, to establish a *prima facie* case of obviousness, MPEP § 2142 requires that the Examiner establish that there is some suggestion or motivation, in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference as alleged by the Examiner. However, in contrast the requirements of the MPEP, the Examiner has not properly identified any suggestion to modify the teachings of Terashima and Lincke to arrive at a light-emission control means for stopping light-emission by a light emitting means upon start of the reception of data by a reception means, as recited in claim 1. In fact, Terashima explicitly teaches away from the Examiner’s proposed modification.

Indeed, Terashima teaches that incandescent lamp 46 is the backlight source for the liquid crystal display 16, and that incandescent lamp 46 is turned “ON” when the lighting control signal Scb reaches a high level. *See* column 5, lines 25-32. Conversely, Terashima teaches that

incandescent lamp 46 is turned “OFF” when the lighting control signal Scb reaches a low level. *See* column 6, lines 15-18. Further, as shown in Figure 2C of Terashima, control signal Scb reaches a high level (and the incandescent lamp 46 is therefore turned “ON”) during the receive and idle slots. *See* Figure 2A; Figure 2C; column 6, lines 7-9. On the other hand, Terashima teaches that control signal Scb reaches a low level (and the incandescent lamp 46 is therefore turned “OFF”) during the transmit slot. *See* Figure 2A; Figure 2C; column 6, lines 15-18.

Hence, Terashima does not teach that control signal Scb stops light-emission by incandescent lamp 46 upon start of the reception of data by antenna 11, as required by claim 1. In fact, Terashima teaches just the opposite—that control signal Scb stops (i.e., turns “OFF”) incandescent lamp 46 upon start of the transmission of data by antenna 11 (i.e., upon the end of the reception of data by antenna 11). Indeed, the fundamental object of Terashima is to provide a wireless communications unit wherein electrical current from the battery to the lighting means is cut off for at least the duration of the transmit interval. *See* column 3, lines 30-35.

Consequently, Terashima expressly teaches away from the feature of a light-emission control means for stopping light-emission by a light-emitting means upon start of the reception of data by said reception means, as required by claim 1.

Moreover, the alleged motivation identified by the Examiner in the 11/24/2004 Office Action for combining Terashima and Lincke, is not supported by the cited references. Lincke does not provide any suggestion that the wireless client 405 shuts down the transmit side for the purpose of ultimately saving power. Rather, Lincke teaches that the wireless client 405 shuts down the transmit side for the simple purpose of closing the TCP connection since a new TCP

connection is to be established for every transaction so as not to consume network resources. *See e.g.*, paragraph 0517-0518. Indeed, while Lincke may suggest that “[h]ardware and software should be optimized to conserve battery power...”, Lincke does not provide any teaching or suggestion to reduce power consumption in the novel manner specified by claim 1, namely, by implementing a light-emission control means for stopping light-emission by a light-emitting means upon start of the reception of data by a reception means. As a result, the Examiner has failed to provide a proper motivation for combining the teachings of Terashima with Lincke, and claim 1 is allowable *at least* for these reasons.

Finally, the cited references do not even factually support the allegations set forth in the grounds of rejection. First, contrary to the grounds of rejection in the 11/24/2004 Office Action, Lincke plainly does not teach or suggest that “the code [i.e., the end-of-file indication] is received and the transmission is shut down ultimately saving power as suggested in paragraph 57.” As discussed above, Lincke teaches that upon transmitting the entire request message, the wireless client 405 shuts down the transmission side of the TCP connection. *See* Paragraph 0517. Therefore, in contrast to the grounds of rejection, Lincke does not teach that transmission is shut down upon receipt of the end-of-file indication.

Moreover, contrary to the grounds of rejection, Lincke also fails to teach or suggest stopping upon detection of a predetermined code. Quite to the contrary, Lincke teaches that “[w]hen the entire request message has been transmitted, the wireless client 405 shuts down the transmit side of the client’s connection, causing the proxy server 180 to receive an end-of-file indication” (emphasis added). Paragraph 0517. Thus, as taught in Lincke, the wireless client

405 stops (i.e., shuts down transmission) when the entire request message has been transmitted, and not upon detection of an end-of-file indication (which the grounds of rejection allege to correspond to a predetermined code, as recited in claim 1). Indeed, Lincke cannot possibly teach that the wireless client 405 stops upon detection of an end-of-file indication, since the wireless client 405 shuts down the transmit side of the client's connection before the end-of-file indication is ever received by the wireless client 405 from the proxy server 180. *See* paragraph 0517, lines 9-13.

In addition, independent claim 1 requires a combination of elements also including *at least*:

...a predetermined code indicative of the end of data received by the reception means; and

light-emission control means for... starting light-emission by said light-emitting means upon detection of said predetermined code by said code detection means.

The Examiner has also failed to establish even a *prima facie* case of obviousness with respect to the above feature. More particularly, the grounds of rejection fail to point to any specific portion of either Terashima or Lincke that teaches or suggests this feature. In fact, the Examiner acknowledges that Terashima fails to teach or suggest this feature. 01/16/2004 Office Action, page 2, lines 18-20. The Examiner also acknowledges that Lincke fails to teach or suggest this feature. 11/24/04 Office Action, page 4, lines 2-4. Rather, the grounds of rejection make the sweeping allegation that "one could be so inclined to control the power of the light-

emitters when a code is detected in any way for the benefit of saving power,” without providing any evidentiary support whatsoever, 11/24/2004 Office Action, page 4, lines 3-4.

Again, the Examiner has summarily concluded that one could be so inclined to invent the novel method of controlling light emission to reduce power consumption recited in claim 1 without establishing any factual basis to support his conclusion, and without providing any objective teaching to this effect in the cited references. Thus, for *at least* reasons analogous to those set forth above, Applicant submits that the Examiner’s rejection is improper.

In particular, Lincke does not provide any teaching whatsoever regarding a means for starting light-emission by a light-emitting means upon detection of a predetermined code by a code detection means, as recited in claim 1. To the contrary, Lincke teaches that “[w]hen the entire request message has been transmitted, the wireless client 405 shuts down the transmit side of the client’s connection, causing the proxy server 180 to receive an end-of-file indication” (emphasis added). Paragraph 0517. Further, Lincke teaches that after the proxy server 180 sends the response back to the request message transmitted by the wireless client 405, it closes down the TCP connection and the wireless client 405 receives an end-of-file indication that the end of the response message has been transmitted. Paragraph 0517. However, Lincke does not teach starting light-emission of any kind, as required by claim 1, nor does Lincke teach starting light-emission by a light-emitting means upon detection of a predetermined code.

Accordingly, Applicant submits that independent claim 1 is patentable over Terashima, Lincke, and any combination thereof, for *at least* the reasons discussed above. Further,

Applicant submits that the dependent claims 2-9 are patentable over Terashima, Lincke, and any combination thereof, *at least* by virtue of their dependency on claim 1.

Thus, the allowance of claims 1-9 is respectfully solicited of the Examiner.

B. Independent Claim 10

In view of the similarity between the recitations set forth in claim 10 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply at least by analogy to independent claim 10. As such, Applicant respectfully submits that claim 10 is patentably distinguishable over Terashima, Lincke, and any combination thereof, *at least* for these reasons. Further, Applicant submits that the dependent claims 11-17 are patentable over Terashima, Lincke, and any combination thereof, *at least* by virtue of their dependency on claim 10.

Accordingly, the allowance of claims 10-17 is respectfully solicited of the Examiner.

C. Independent Claim 21

In view of the similarity between the recitations set forth in claim 21 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply at least by analogy to independent claim 21. Accordingly, Applicant respectfully submits that claim 21 is patentable over Terashima, Lincke, and any combination thereof, *at least* for these reasons. Further, Applicant submits that the dependent claims 22-24 are patentable over Terashima, Lincke, and any combination thereof, *at least* by virtue of their dependency on claim 10.

Hence, the allowance of claims 21-24 is respectfully solicited of the Examiner.

D. Independent Claim 25

In view of the similarity between the recitations set forth in claim 25 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply at least by analogy to independent claim 25. Accordingly, Applicant respectfully submits that claim 25 is patentable over Terashima, Lincke, and any combination thereof, *at least* for these reasons.

Hence, the allowance of claim 25 is respectfully solicited of the Examiner.

IV. Claim Rejections under 35 USC § 103 – Terashima in view of Lincke

The Examiner has rejected claims 26-30 under 35 U.S.C. §103(a) as being unpatentable over Terashima, in view of Lincke, and further in view of U.S. Patent No. 6,287,887 to Son *et al.* (hereinafter “Son”). Applicant submits that the dependent claims 26-30 are patentable over Terashima, Lincke, Son, and any combination thereof, *at least* by virtue of their dependency on claim 1. Indeed, Son does not cure the deficient teachings of Terashima and Lincke. Thus, the allowance of claims 26-30 is respectfully solicited of the Examiner.

V. Conclusion

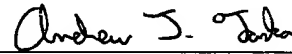
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 09/685,770

Attorney Docket No.: Q61175

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: February 23, 2005